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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/555,095

11/02/2005

Paola Del Vecchio

023349-00310

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EXAMINER

DANG, HUNG XUAN

ART UNIT

PAPER NUMBER

2873

NOTIFICATION DATE

DELIVERY MODE

03/14/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DCIPDocket@arentfox.com  
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<b>Office Action Summary</b>	<b>Application No.</b> 10/555,095	<b>Applicant(s)</b> DEL VECCHIO, PAOLA	
	<b>Examiner</b> Hung X. Dang	<b>Art Unit</b> 2873	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12/12/07.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-73 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-73 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/02/05, 12/12/07</u> . | 6) <input type="checkbox"/> Other: _____  |

1. The Restriction requirement mailed on 10/2/07 is withdrawn. Claims 1-36 and claims 37-73 will be exam together.

### **Information Disclosure Statement**

2. The prior art documents submitted by applicant in the Information disclosure Statements filed on 12/12/07 has been considered and made of record (noted attached copy of form PTO-1449).

The cited prior art in the Information Disclosure Statement filed on 11/02/05 has not been consider by Examiner because Applicant did not submit the copies of the foreign prior art.

### **Claims Rejection Under 35 U.S.C. 112**

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-73 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The numerals in the parentheses make the claims vague and confuse.

### **Claims Rejection Under 35 USC - 102**

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 9-37 and 45-73 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Goodman et al** (3,740,124).

Goodman et al discloses floatable eyeglasses comprises a frame 1, wherein the frame having a cavity 15, a pair of temple 12 and 13, wherein the temples 12 and 13 having a pair of cavity 16 and 17 respectively (see figures 1-3 and the related disclosure.)

It should be noted that although claims 1, 9-36 are "a process claims", the process claims have no process steps and therefore these steps would be inherently satisfied by the apparatus of the reference as modified.

### **Claims Rejection Under 35 USC - 103**

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 4-8, 38 and 40-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Goodman et al** (3,740,124).

Goodman et al discloses floatable eyeglasses comprises a frame 1, wherein the frame having a cavity 15, a pair of temple 12 and 13, wherein the temples 12 and 13 having a pair of cavity 16 and 17 respectively (see figures 1-3 and the related disclosure.)

Goodman et al does not teach injecting the filler gas into the cavity.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to injecting the filler gas into the cavity, Since it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. In re Karlson, 136 USPQ 184.

It should be noted that although claims 2 and 4-8 are "a process claims", the process claims have no process steps and therefore these steps would be obviously satisfied by the apparatus of the reference as modified.

#### **Allowable Subject Matter**

6. Claims 3 and 39 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 2873

**Art Pertinent**

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure Feldman(5,946,071) and Silver (6,069,742) teach eyeglass frame have a cavity which is considered pertinent to the claimed invention.

8. Any inquiry concerning this communication should be directed to Examiner Dang at telephone number (571) 272-2326.

3/08

/HUNG DANG/

PRIMARY EXAMINER

TC 2800